

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: *Libman*

Art Unit: 3622

Serial No.: 09/592,086

Examiner: Alvarez, Raquel

Filed: *June 12, 2000*

For: *Apparatus for Preparing Client
Communications Involving Financial Products and
Services*

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

**Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Dear Sir:

Applicant respectfully submits that there are clear errors in the present rejections, and that one or more essential elements needed for a prima facie rejection - specifically identified below - have been omitted at this time. Because the only primary reference cited at this time (De Lapa – US Patent No. 5,822,735) has notable and manifest deficiencies, Applicant submits that the Examiner will not be able to meet the appropriate burden in this case. Accordingly, Applicants submit that the claims should be allowed in their present form.

Applicants further wish to note that a Request for Reconsideration/Petition to Withdraw the Finality of the Office Action was filed in the instant case on September 6, 2005. This filing is incorporated by reference herein. The September 6 Request points out the obvious deficiencies in the present record to support a final rejection based on De Lapa, because the Examiner has failed to address key limitations in the claims added by amendment as far back as April 1, 2004. As no action has been taken on the September 6 request by the PTO at this time, Applicant is compelled to file the present submission to preserve his rights in this case.

BRIEF ARGUMENTS IN SUPPORT OF REQUEST

Claims 1 – 159 are pending. Of these, only claims 1, 64 and 159 are independent.

The claims are generally directed to methods and apparatus for automatically preparing communications offers of financial products/services. The only reference applied at this time against the claims is De Lapa – US Patent No. 5,822,735, which is cited by the Examiner under § 103 as making the claims obvious.

For purposes of the present Pre-Appeal Brief, Applicant is intentionally confining the substance of the discussion to the language noted in bold below in claim 1 to simplify review and consideration. This is done without waiver or prejudice to argue other perceived deficiencies in a formal appeal brief:

1. A method of automatically preparing communications offering one or more financial products or financial services, the method comprising:

(1) automatically determining whether to offer a financial product or a financial service to an entity, said entity being from an entity set comprising a plurality of entities, said financial product or said financial service being from a financial product/service set comprising at least one of (a), (b) and (c):

(a) one or more financial products or one or more plans relating thereto;

(b) one or more financial services or one or more plans relating thereto;

(c) one or more financial products and one or more financial services or one or more plans relating thereto;

(2) if it is determined to offer said financial product or said financial service to said entity, then automatically determining variable information for inclusion in a communication for said entity; and

(3) automatically generating the communication for said entity if it is determined to offer said financial product or said financial service to said entity, the communication including an offering to said entity for said financial product or said financial service, the communication having a communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, wherein content of said offering in said communication includes the variable information such that the offering comprises variable content, wherein said variable information in said offering at least partially at least one of identifies, specifies and promotes said financial product or financial service being offered to said entity, wherein said variable information may vary among persons being offered said financial product or said financial service such that offers of said financial product or said financial service to said persons may vary from person to person;

wherein steps (1), (2) and (3) are performed using one or more data processing devices within an automated process; and

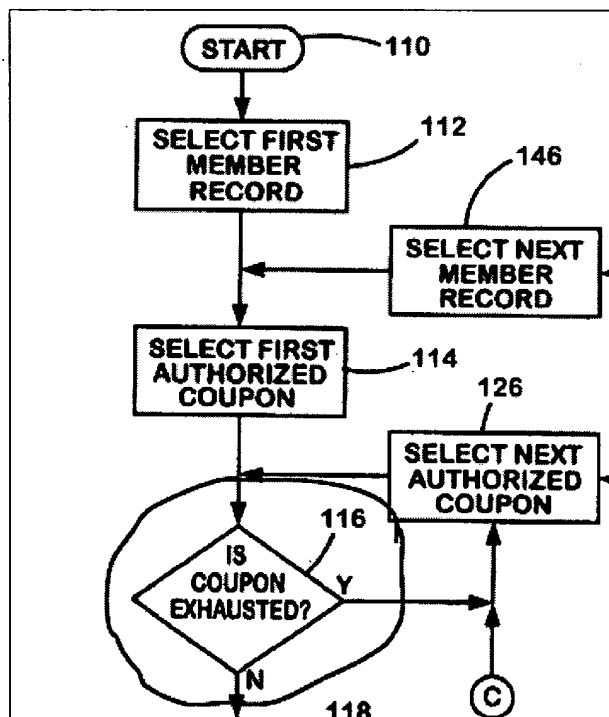
wherein steps (1), (2) and (3) are performed for each entity in said entity set and for each financial product and financial service in said financial product/service set, such that each financial product and financial service in said financial product/service set is considered for possible offering to each entity in said entity set.

The bulk of the language in the limitation noted in bold was added in Applicant's April 1, 2004 amendment incorporated by reference herein. In the April 1 Remarks, the Applicant pointed out how such limitation clearly distinguished over De Lapa:

"... De Lapa does not teach or suggest evaluating each product for possible offer to each customer. De Lapa operates until a customer's coupon sheet is full. Once it is full, De Lapa stops evaluating products for the customer..."

Since the April 1 2004 Amendment the Examiner has never: (a) addressed this limitation; (b) rebutted the argument made by Applicant, or (c) made any attempt to explain how the De Lapa reference meets such language. At this time, therefore, Applicants are without the benefit of any citation, fact, or argument from the Examiner to understand and evaluate the basis for maintaining the present rejection.¹

Nonetheless Applicant submits the following additional analysis to explain how De Lapa appears to be woefully deficient on this point, and, in fact, appears to teach away from the invention. Here is the pertinent feature from De Lapa which relates to Applicant's contention:



This flow chart shows that the De Lapa reference clearly operates from a “coupon supply” perspective, meaning that there is a finite supply of coupons, and they are doled out

¹ This omission is addressed in detail in the September 6 Request and is not repeated herein. The panel is invited and encouraged to review the Request and the Office Actions subsequent to April 1 2004 to confirm Applicant's position.

to customers based on some program logic² until the supply is exhausted. Once the last coupon of a particular type is sent to a customer, there is no ability or means identified to offer such coupon to a subsequent customer. That this is true can be confirmed quite easily from reviewing the operation of De Lapa's program at col. 14, ll. 30+. Thus, in the above figure, when the coupon is exhausted at step 116, the "next" authorized coupon must be considered at step 126.

What this means is that it is impossible within the De Lapa reference to meet the limitation of claim 1, wherein "...each financial product and financial service in said financial product/service set is considered for possible offering to each entity in said entity set." Because De Lapa exhausts his coupon offerings, some of them they clearly cannot be offered to later customers. The practical effect of this, as seen in column 15, is that by the time De Lapa starts to consider coupons for later customers in the database, these persons are constrained in that they are only being offered a now more limited and reduced selection set of items,³ (which may or may not be appropriate to their needs or interests).

The present invention suffers from no such restriction, because it approaches the problem from the other direction: namely, how to satisfy customers by presenting them with the most appropriate set of items for their needs in a communication. De Lapa only considers the "coupon distribution" perspective, and considers the customer only secondarily; this part of the disclosure is most telling:

"...the cyclic coupon selection mailing routine selects coupons by consumer, rather than vice versa" See, e.g., col. 15, ll. 46+.

In other words, for any particular consumer, De Lapa only ever looks at a very narrow subset of coupons that may be pertinent to that person's interests – in fact, just enough to fill out the coupon sheet noted in Figure 2. Consequently, nowhere does De Lapa hint or suggest at the type of method/apparatus described in the present claims. One of the key criteria needed to establish *prima facie* obviousness of a claimed invention is that **all the claim limitations must be taught or suggested by the prior art**. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ

² Applicant contends that the logic used to dispense coupons is also probably distinguishable, but elaboration of this point is unnecessary at this time.

³ Applicants submit that this points out the inherent and fundamental weakness in attempting to equate unrelated references concerning generic "products" which are quite different from the financial product/service areas of the present inventions. This point is not explicitly relied upon herein but could be incorporated in any appeal brief which may be necessary in the present proceedings.

494, 496 (CCPA 1970). *See, e.g.*, MPEP 2143.03; 706.02(j).

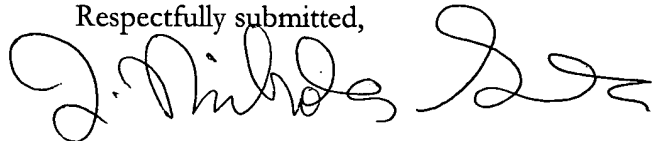
In this instance, the Examiner has failed to explain how certain limitations in the claim are met by the reference. On this basis, the present claims are clearly allowable over the reference.

Moreover, for De Lapa to be relevant, the Examiner would have to modify the operation of such system to be 180° opposite from what is stated as the primary logic of such routine. It is incontrovertible therefore that De Lapa teaches away from solving the problem of communicating the most appropriate set of items to a particular customer. A finding of obviousness is fundamentally unsupportable under such circumstances. See *In re Grasselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983).

CONCLUSION

For the reasons set forth above, Applicant requests that the claims are clearly patentable, since nothing in the reference has been identified by the Examiner to correspond to the pertinent limitations of the claim.

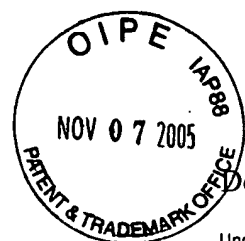
Respectfully submitted,



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I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to Mail Stop AF, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 this 4th day of November 2005.



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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) LIB 2005-01	
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		First Named Inventor Libman	
		Art Unit 3622	Examiner Racquel Alvarez
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 34,175 Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p><i>J. Nicholas Gross</i> Signature J Nicholas Gross Typed or printed name 510-540-6300 Telephone number November 4, 2005 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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